

## In the Claims

### Listing of Claims

1. A method for achieving a most favored risk management using a computer-based system comprising:
    - a) Means of providing risk management insurance policy coverage of at least Breach of Computer Security of the "Computer-Based System".
    - b) Means of comparing investment costs of risk prevention computer-based technology with one or more risk insurance policies.
  2. A method of risk management that provides investment comparison of insurance and computer-based technology alternatives comprising:
    - a) Means of expressing risks to Company assets in common currency.
    - b) Means of expressing risk coverage of one or more computer-based technologies into common currency.
  3. A method of risk management that expresses risks to company assets in common currency comprising:
    - a) Means of analyzing a Company's transactions and their corresponding effect on a Company's assets and expressing that risk in common currency.
    - b) Means of determining the flow of a Company's computer-based transactions and ranking them by risk expressed in common currency.
- a)

4. A method of expressing risk coverage of one or more computer-based technologies into common currency comprising:

b) Means of establishing a baseline of network risk through vulnerability study.

c) Means of expressing computer-based technology investment risk in terms of common currency by estimating of at least one of the followings:

(1) Number of people creating the risk.

(2) The policy that can be developed and enforced in this risk area.

(3) The value of the computer-based intellectual property available to this risk area.

Please amend the claims as follows

Claim 1. (Canceled)

Claim 2. (Canceled)

Claim 3. (Currently Amended)

1. A system, which employs both computerized and expert editorial standardization, of risk management comprising:

a) a system of risk management analyzing a Company's business transactions and providing investment comparison of insurance risk mitigation and computer-based technology alternatives for risk mitigation, in common currency of the Company.

- b) a system of risk management analyzing a Company's business processes and providing investment comparison of insurance risk mitigation and computer-based technology alternatives for risk mitigation, in common currency of the Company.
- c) a system expressing computer-based technology alternatives investment risk in terms of a Company's common currency by estimating of at least one of the followings:
  - (1) Number of people creating the risk.
  - (2) The policy that can be developed and enforced in this risk area.
  - (3) The value of the computer-based intellectual property available to this risk area.

Claim 4. (Canceled)

**1. Claim Rejections -35 USC 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claim 3 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non- statutory subject matter.

Claim 3 comprises "means of analyzing" and "means of determining". In the context of the disclosure, the means are elements of a computer code or computer program. Since the computer codes themselves cannot produce a useful result without being acted upon by a computing device (a computer or processor) the claimed invention is inoperative and therefore lacks utility.

Amend claim to read "a computer,

a computer-readable memory device in

communication with the computer comprising the following:

means for analyzing..

means for determining

Answer

The Claim was amended to read "A system, which employs both computerized and expert editorial standardization, of risk management comprising:

A system of ..

A system of .."

**2. Claim Rejections -35 USC 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall it forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement The claim(s) contains subject matter, which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to describe the following features in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

--expressing risk associated with a company's assets in common currency by analyzing the company's transactions. (see limitation c) of claim 3.)

ranking computer-based transaction by risk expressed in common currency. (see limitation d) of claim 3.)

It is the examiner's position that nothing within the scope of the claims is enabled.

The applicant's is requested to provide detailed explanation, as to, how and where, the specification as originally filed, describes the aforementioned limitations in such a manner as to reasonably convey to one skilled in the relevant art the inventor, at the time the application was filed, had possession of the claimed invention.

Answer

Amended claim 3 now enables the measurement of risk in the system described in the specification and in the claim. The system concept and language are now consistent.

### **3. Claim Rejections -35 USC 112**

The following is a quotation of the second paragraph of 35 USC § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 3 states that it is directed to a method claim. However, the body of the claim recites elements of an apparatus or a system ("Means of.."). It is interpreted that the claim preamble is "A system of..".

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: relationship of the means of analyzing c) to means of determining d). In the present form no structural cooperative relationship exists between the two elements of the claim. Therefore, the examiner cannot ascertain the applicant's invention.

Answer

Amended claim 3 now enables the structure for measurement of risk in the system elements described in the specification and in the claim. The structure of comparison of risk mitigation insurance and risk mitigation technologies alternatives is apparent.

Respectfully submitted,

A handwritten signature in cursive script, reading "William J. Reid". The signature is written in dark ink and is positioned above the printed name.

William J. Reid

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